[247] Attorney Docket No. : ADP-122RE PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Reissue Application of:

Applicant	:	Jeffrey T. Kohli
Serial No.	:	10/141,286
Filed	:	May 8, 2002
For	:	GLASSES FOR DISPLAY PANELS AND PHOTOVOLTAIC DEVICES
Examiner	:	S. Stein
Group	:	1775

For the Reissue of:

Patent No.	:	6,060,168
Granted	:	May 9, 2000
For	:	GLASSES FOR DISPLAY PANELS AND PHOTOVOLTAIC DEVICES
Patentee	:	Jeffrey T. Kohli

Commissioner of Patents and Trademarks
Washington, D.C. 20231

RESPONSE

This is in response to the non-final Office Action dated September 9, 2003.

Submitted herewith is a petition under 37 CFR §1.136 and the required fee requesting a one month extension in which to file this paper. With the extension, this response is due on January 9, 2004.

In the September 9th Office Action, the Examiner entered a double patenting rejection based on commonly-assigned U.S. Patent No. 6,319,867 (the "'867 patent") and co-pending application No. 09/990,750 (the "'750 application"), which claims priority from the '867 patent. In the '750 application, a double patenting rejection has also been made based on the

present application. See the August 26, 2003 Office Action for the '750 application, a copy of which is attached hereto as Exhibit A.

Although some of the limitations of the claims of this application and those of the '750 application and the '867 patent overlap, applicant does not agree that the claims are patentability indistinct. For example, all of the claims of the '750 application and the '867 patent include limitations calling for a liquidus viscosity at least greater than about 200,000 poise. None of the claims of this application contain such a limitation. Conversely, all of the claims of this application include a limitation requiring SrO + BaO to be less than 3.0 wt.%. No such limitation appears in the claims of the '750 application or the '867 patent.

However, to facilitate the prosecution of this application, submitted herewith is a terminal disclaimer for the present application directed to the '867 patent and the '750 application. Simultaneous with the submission of this terminal disclaimer, a terminal disclaimer is also being submitted in the '750 application directed to this application and the '867 patent. A copy of that terminal disclaimer, as well as the response being submitted in the '750 application to the August 26th Office Action for that application, are attached hereto as Exhibit B.

The terminal disclaimers in this application and in the '750 application are being made without prejudice and their sole purpose is to obviate the double patent rejections made in this application and the '750 application. Pursuant to the holding in, for example, Quad Environmental Technologies Corp. v. Union Sanitary District, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991), these terminal disclaimers are not to be construed in any way as an obviousness admission with regard to any of the claims of this application or the '750 application.

In addition to the double patent rejection, in the September 9th Office Action, the Examiner again rejected certain of applicant's claims as allegedly anticipated by Example 9 of Kushitani et al., U.S. Patent No. 5,244,847 (Kushitani US '847). Specifically, independent Claims 50-53 and their dependent Claims 60-63 were rejected based on this example.[1]

In response to the Examiner's previous rejection based on Example 9 of Kushitani US '847 (11/12/02 Office Action, ¶4), applicant submitted a declaration under Rule 132 from Dr. Josef C. Lapp, which reported calculated coefficient of thermal expansion (CTE) values for Corning's commercial Glass Composition No. 1737 for a variety of temperature ranges that appear in the patent literature relating to LCD glasses. The declaration also set forth a table of offsets for use in transforming CTE values from one range to another. As stated in paragraph 8 of his declaration, in Dr. Lapp's opinion, the CTE offsets determined for Corning's Glass Composition No. 1737 "should be applicable to other LCD glass compositions which use SiO_2, B_2O_3, and Al_2O_3 as glass formers and MgO, CaO, SrO, and/or BaO as modifiers."

Although acknowledging this opinion of Dr. Lapp, the Examiner argued in the September 9th Office Action that:

> The affidavit does not provide evidence as to the temperature offsets for the Asahi glass composition in the Kushitani reference. This affidavit provides evidence only with respect to Corning glass 1737 and only provides conjecture that the disclosed glass in Kushitani would not inherently have the claimed CTE value over the particular temperature range. Therefore, the rejections based on this reference are still

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[1] Dependent Claim 59 was also listed in the Office Action as being rejected based on Example 9 of Kushitani US '847, but applicant believes that this is a typographical error since Claim 59 does not depend on any of independent Claims 50-53.

> deemed proper and have been applied to new claims 50-53 and 59-63. (9/9/03 Office Action at page 5.)

Applicant respectfully traverses this rejection on the grounds that based on the Lapp Declaration, applicant believes that the Examiner has not met his initial burden of establishing a *prima facie* case of anticipation of Claims 50-53 and 60-63 by Example 9 of Kushitani US '847.

The Examiner's basic argument with regard to the Kushitani reference is as follows:

> With regard to the limitation of the CTE [i.e., 30-41.5x10^{-7}/°C over the temperature range 25-300°C], while it is noted that Example 9 does disclose that the Thermal expansion coefficient is 44x10^{-7}/°C, there is no temperature range disclosed for this particular CTE value, <u>therefore it is presumed</u> that the disclosed composition will have a CTE value within the claimed range for the claimed temperature range, since the reference discloses a composition within the claimed ranges. (9/9/03 Office Action at page 3; emphasis added.)

Applicant respectfully submits that in view of the Lapp Declaration, the Examiner's "presumption" is without scientific or technical basis. That declaration provides evidence that Example 9 of Kushitani US '847 can be expected to have a CTE above 41.5x10^{-7}/°C over the temperature range 25-300°C.

Accordingly, based on the Lapp declaration, applicant respectfully submits that the proper presumption is that Example 9 of Kushitani US '847 does <u>not</u> have a CTE in applicant's claimed range. That being the case, applicant further submits that the Examiner has not established a *prima facie* case of anticipation of Claims 50-53 and 60-63 by Example 9 of Kushitani US '847.

The need for a scientific basis to support an inherency rejection was discussed by the Board in Ex parte Skinner, 2 U.S.P.Q.2d 1788, 1788-9 (Bd. Pat. App. & Interfer. 1986):

> It is by now well settled that the burden of establishing a *prima facie* case of anticipation resides with the Patent and Trademark Office. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) quoting *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967). It is the examiner's position that the mold of Mizutani *may* inherently have the characteristics of the claimed mold. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323 (CCPA 1981). We are mindful that there is a line of cases represented by *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971) which indicates that where an examiner has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, the examiner possesses the authority to require an applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. Nevertheless, before an applicant can be put to this burdensome task, the examiner must provide some evidence or scientific reasoning to establish the reasonableness of the examiner's belief that the functional limitation is an inherent characteristic of the prior art. In the case before us, no such evidence or reasoning has been set forward. (Italics in original; emphasis added.)

A similar discussion of the applicable law appears in Ex parte Levy, 17 U.S.P.Q.2d 1461, 1463-4 (Bd. Pat. App. & Interfer. 1990):

> [T]he initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention rests upon the examiner. *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the

> applied prior art. *In re King*, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); *In re Oelrich*, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); *In re Wilding*, 535 F.2d 631, 190 USPQ 59 (CCPA 1976); *Hansgirg v. Kemmer*, 102 F.2d 212, 40 USPQ 665 (CCPA 1939). In our opinion, the examiner has not discharged that initial burden. (Italics in original.)

In view of this precedent and the facts of this case, specifically, the data and calculations of the Lapp Declaration, applicant respectfully submits that the Examiner's rejection based on Kushitani US '847 should be withdrawn, and such action is respectfully requested.

Based on the foregoing, applicant believes that this application is now in condition for allowance. Accordingly, reconsideration and the issuance of a notice of allowance for the application are respectfully requested.

Respectfully submitted,

Date: January 5, 2004 Maurice Klee

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TERMINAL DISCLAIMER

This terminal disclaimer is being submitted to obviate a provisional double patenting rejection over a pending second application, namely Application No. 09/990,750 filed on November 16, 2001 (the "Second Application").

The owner, Corning Incorporated, of the entire interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application that would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 (as shortened by any terminal disclaimer filed prior to the grant of any patent granted on the pending Second Application) of any patent granted on the pending Second Application.

The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the Second Application are commonly owned. This

agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the Second Application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

The owner also hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,319,867 (the '867 patent).

The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the '867 patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35

U.S.C. 154 to 156 and 173 of the '867 patent, as presently shortened by any terminal disclaimer, in the event that the '867 patent later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

The undersigned is an attorney of record.

Respectfully submitted,

Date: January 5, 2004

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